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Sandra Parkington

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INTELLECTUAL PROPERTY GROUP
FREDRIKSON & BYRON, P.A.
200 SOUTH SIXTH STREET
SUITE 4000
MINNEAPOLIS, MN 55402

EXAMINER

NAQI, SHARICK

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/756,179	Applicant(s) PARKINGTON, SANDRAp	
	Examiner Sharick Naqi	Art Unit 3736	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 10-14, 17-19 and 23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 15-16 and 20-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
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| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input checked="" type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/20/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

This application contains claims directed to the following patentably distinct species:

Species 1 drawn to the embodiment disclosed in figures 3-4;

Species 2 drawn to the embodiment disclosed in figure 6;

Species 3 drawn to the embodiment disclosed in figure 7a; and

Species 4 drawn to the embodiment disclosed in figure 8.

The species are independent or distinct because claims to the different species recite the mutually exclusive characteristics of such species. In addition, these species are not obvious variants of each other based on the current record.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently claims 1-9, 16 and 22 are generic.

There is an examination and search burden for these patentably distinct species due to their mutually exclusive characteristics. The species require a different field of search (e.g., searching different classes/subclasses or electronic resources, or employing different search queries); and/or the prior art applicable to one species would not likely be applicable to another species; and/or the species are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species to be examined even though the requirement

may be traversed (37 CFR 1.143) **and (ii) identification of the claims encompassing the elected species**, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

The election of the species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the election of species requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected species.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the species unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other species.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141.

During a telephone conversation with Applicant's representative Charles D. Segelbaum on March 26, 2008 a provisional election was made without traverse to prosecute the invention of species 4, claims 1-9, 15, 16 and 20-22. Affirmation of this election must be made by applicant in replying to this Office action. Claim 10-14, 17-19 and 23 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Objections

Claims 4, 5, 6 and 21 are objected to because of the following informalities:

In regards to claim 4 and 5, each additional method steps in claims 4 and 5 use the same letters (a, b, c) as the steps in independent claim 1. Examiner suggests that the new method steps be called steps e, f, g, h and i.

In regards to claim 6, line 2 "a health specialists" is a typographical error and should be corrected to "a health specialist."

In regards to claim 21, line 1 states "[T]he device of claim 19, wherein said programmable computer system is ..." However the programmable computer system is not mentioned in withdrawn claim 19. Examiner suggests that claim 21 be amended to depend upon claim 20 where a programmable computer system is first mentioned.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 1 is rejected under 35 U.S.C. 101 because the claimed invention is not supported by a tangible result.

The claims lack a practical application because a useful, concrete, and tangible result because a real-world value is not produced. *Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility*, United States Patent and Trademark Office Official Gazette Notices (November 22, 2005) ("*Interim Guidelines*"), *Interim Guidelines* §IV(C)(2)(b)(2)).

The preamble of the method claim 1 "[a] method for tracking sodium intake" lacks a clear nexus with the body of the claim. The body of the claim has steps for determining an amount of sodium a user is allowed to consume in a period and the amount of sodium a user actually consumes, converting the amounts into points using a preset ratio and maintaining a running sum of total sodium consumption in points. Most importantly, although a calculation is performed by maintaining a running sum of sodium intake points, it is not disclosed as being outputted in some form or another. In other words, the calculation lacks a result, and it is the examiner's position that a calculation without result lacks real world value.

Although not determinative of statutory subject matter, in this case it seems notable that claim 1 does not require the use of any structure to perform the calculation, and the determination and maintaining steps can be reduced to steps performed in the human mind. Thoughts or steps in the human mind may be considered abstract ideas lacking real-world value.

Claim 16 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In regards to claim 16, Applicant claims "[a] device for tracking sodium intake comprising: a) a table setting forth in a user readable format . . . and b) a second number scale ..." It appears that the Applicant is trying to claim an apparatus but the claim has no structure associated with it because the claimed elements of "a table" and "a second number scale" are simply information or data. Data by itself is non-statutory subject matter. As such the claimed invention does not fall within at least one of the four categories of patent eligible subject matter recited in 35 U.S.C. 101 (process, machine, manufacture, or composition of matter).

Claim 22 is rejected under 35 U.S.C. 101 because the claimed invention is not supported by a tangible result.

The claims lack a practical application because a useful, concrete, and tangible result because a real-world value is not produced. *Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility*, United States Patent and Trademark Office Official Gazette Notices (November 22, 2005) ("*Interim Guidelines*"), *Interim Guidelines* §IV(C)(2)(b)(2)).

The preamble of the method claim 22 "[a] method for recording dietary sodium intake" lacks a clear nexus with the body of the claim. The body of the claim has steps for converting weights of dietary sodium into points using a preset ratio and tabulating a cumulative dietary sodium intake by accumulating points. Most importantly, although a calculation is performed by accumulating points and tabulating a cumulative dietary sodium intake, it is not disclosed as being outputted in some form or another. In other

words, the calculation lacks a result, and it is the examiner's position that a calculation without result lacks real world value.

Although not determinative of statutory subject matter, in this case it seems notable that claim 22 does not require the use of any structure to perform the calculation, and the converting and tabulating steps can be reduced to steps performed in the human mind. Thoughts or steps in the human mind may be considered abstract ideas lacking real-world value.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8, 15, 16 and 20-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Mault et al. US Patent Publication Number 2002/0133378.

1. A method for tracking sodium intake comprising the steps of:

a. determining an amount by weight, of a standard measurement system, of dietary sodium a subject is allowed to consume during an intake period (Fig 3k shows Nutrient Target daily target for sodium set at 2400 mg.);

b. converting the amount by weight of dietary sodium so determined into intake points by use of a preset ratio of the amount by weight of the standard measurement

system to intake points (Fig-8C shows the daily Nutrient totals set up to be displayed as percentage points where 100% would be equal to 2400mg for Sodium.);

c. determining the amount by weight of the standard measurement system of dietary sodium in a portion of food that will be consumed by the subject (Fig -15 Meal Logging shows amount of sodium in the meal.);

d. converting the amount by weight of the standard measurement system of dietary sodium in the portion of food to be consumed to intake points by use of said preset ratio (Fig -15 Meal Logging also shows percentage of daily value of sodium in the meal.); and

e. maintaining a running sum of intake points which are equivalent to dietary sodium consumed by the subject during the intake period (Figure 8-C shows daily sodium intake total. Fig – 19A shows percentage of sodium consumption in chart that can be determined over any period of time, including a day if the start day and end day are set to be the same.).

2. The method of claim 1 including the further step of repeating steps a. to e. for successive intake periods (Fig -19A shows that the steps can be repeated every day.).

3. The method of claim 2 includes the step of making each intake period a day (Figure 8-C shows daily sodium intake total. Fig – 19A shows percentage of sodium consumption in chart that can be determined over any period of time, including a single

day if the start day and end day are set to be the same.).

4. The method of claim 1 including the further steps of:

a. recording the weight of the subject at the beginning of each intake period (Fig 17 discloses recording actual and estimated weight values.); and

b. recording the weight of the subject at least once per day (Fig 17 discloses recording actual and estimated weight values.).

5. The method of claim 4 including the further steps of:

a. determining the change in weight between the weight recorded at the beginning of the intake period as compared to the weight taken at the beginning of the previous intake period (Paragraph 0072);

b. determining if the change in weight exceeds a preset threshold amount (Paragraph 0072);

and

c. taking remedial action if the change of weight exceeds the threshold amount (Paragraph 0072).

6. The method of claim 5 wherein the step of taking remedial action is consulting with a health specialists (Paragraph 0072).

7. The method of claim 1 wherein the standard measurement system used is selected from the group of the English system or the Metric system (The figures show that the Metric system is used.).

8. The method of claim 1 wherein the standard measurement system is the Metric system (The figures show that the Metric system is used.).

15. The method of claim 1 wherein the step of maintaining a running sum of intake points during an intake period comprises the step of cumulatively counting the sum on a programmable electronic device having a human input interface for inputting intake numbers, a memory for retaining information inputted, to include a removable data storage memory stick, a visual display for reading information input and a cpu for controlling function (Paragraphs 0025, 0045, 0069 and 0105 describe the computing device.).

16. A device for tracking sodium intake comprising:

a) a table setting forth in a user readable format a ratio based relationship between dietary sodium by quantity and an intake point numbers scale (Fig 15 and Fig 20B show a Nutrition Facts table where an quantity of sodium is shown corresponding to a certain percentage point level, this is a ratio based relationship. The user is able to look at different meals/recipes with different sodium levels and the corresponding percentage point numbers.); and

b) a second number scale presented in a format that allows for the cumulatively counting of intake point numbers to thereby allow for the counting of total intake point numbers that are equivalent to sodium intake of an individual using the device (Fig 8C shows total sodium intake for a day as a total percentage.).

20. The device of claim 16 further comprising a programmable computer system including a user input interface, a visual display, internal and removable portable memory, cpu and functional circuitry (Paragraphs 0025, 0045, 0069 and 0105 describe the computing device.) and wherein said table is implemented in a electronic format for storage in said memory and retrievable for display when necessary and said second scale implemented in an electronic format for storage in said memory and available thorough said user interface for incrementally counting and saving a summation of total intake points accumulated during a preset period (Fig 20B, Fig8C and paragraph 0087. Balancelog data is stored in the memory of the computing device and can be accessed via the menu screens. The selection tabs show that historical data can be pulled up for different time periods, including the current day.).

21. The device of claim 19 wherein said programmable computer system is selected from a group including: a personal computer, a personal digital assistant, and electronic calculator and a cellular telephone (Paragraph 0041 gives description of computing device as any one of a number of electronic devices, including a PDA.).

22. A method for recording dietary sodium intake comprising the steps of:

a. converting the weights of dietary sodium intake to a simple sodium point measurement system where each sodium point represents a fix ratio of a standard weight measurement of dietary sodium (Fig 3k shows Nutrient Target daily target for sodium set at 2400 mg and Fig-8C shows the daily Nutrient totals set up to be displayed as percentage points where 100% would be equal to 2400mg for Sodium.); and

b. tabulating cumulative dietary sodium intake by accumulating sodium points representative of a patient's amount of sodium intake (Figure 8-C shows daily sodium intake total.).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mault et al. US Patent Publication Number 2002/0133378.

In regards to claim 9, at the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to set the preset ratio as 100 milligrams of sodium per one intake point because Applicant had not disclosed that this particular ratio provided an advantage, is used for a particular purpose, or solved a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with any preset ratio, including one where each point equals 240mg of sodium (100 percentage points is equal to total daily intake of 2400mg.) because with this ratio, sodium intake can still be presented to the user in point form as required by the invention.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharick Naqi whose telephone number is (571)272-3041. The examiner can normally be reached on 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on 571-272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. N./
Examiner, Art Unit 3736

/Michael Astorino/
Primary Examiner, Art Unit 3736

March 26, 2008